

**REMARKS/ARGUMENTS**

In an Office Action dated 18 December 2003, the Examiner rejected claims 1 – 15, 18 – 21, 23 – 37, and 40 – 43 under 35 U.S.C. §102(e) as being anticipated by U.S. Pat. App. No. 09/373,625 filed by Granger, *et al.* The Examiner further rejected claims 16, 17, 22, 38, 39, and 44 under 35 U.S.C. §103(a) as being unpatentable over Granger *et al.*

***Claim Rejections – 35 U.S.C §102(e)***

Applicant has reviewed the Examiner's rejections as well as the claims as initially filed. The Examiner rejected claims 1 – 15, 18 – 21, 23 – 37, and 40 – 43 under 35 U.S.C. §102(e) as being anticipated by U.S. Pat. App. No. 09/373,625 filed by Granger, *et al.*, noting with respect to the claims:

As per claim 1, Granger teaches an automated gift certificate generation system for automatically identifying merchants to generate a gift certificate based on a location, comprising:

means for receiving gift certificate data that designates a plurality of gift certificate data including at least one of: geographic location, merchant identification, recipient profile, recipient address, monetary value of said gift certificate, product characteristics, mode of delivery, delivery date (Granger, page 1, [1008], "...a person can receive promotions information,...");

means for automatically identifying at least one merchant located in an area located proximate at least one of: said address of said gift certificate recipient and said geographic location (Granger, page 2, [0019]-[0020]);

means for enabling said user to select at least one of said identified merchants (Granger, page 6, [0074]); and

means for generating a gift certificate that defines a monetary amount of said gift certificate and said selected merchant (Granger, page 1, [0008]).

As per claim 2, Granger teaches all the claimed subject matters as discussed in claim 1, and further teaches responsive to establishment of a communication connection from a terminal device of said user to said automated gift certificate generation system, for transmitting a plurality of user data entry screens, seriatim to said terminal device to enable said user to input said gift certificate data (Granger, page 6, [0074]).

As per claim 3, Granger teaches all the claimed subject matters as discussed in claim 2, and further teaches responsive to receipt of gift certificate data indicative of a location of a recipient profile, for uploading said recipient profile from said location (Granger, page 2, [0020]).

As per claim 4, Granger teaches all the claimed subject matters as discussed in claim 2, and further teaches receiving data from said user that defines a radius from said at least one of: said address of said gift certificate recipient and said geographical location as said area located proximate at least one of: said address of said gift certificate recipient and said geographic location (Granger, page 4, [0053]).

As per claim 5, Granger teaches all the claimed subject matters as discussed in claim 1, and further teaches enabling said user to select a gift certificate from database of gift certificates (Granger, page 6, [0074]).

As per claim 6, Granger teaches all the claimed subject matters as discussed in claim 5, and further teaches enabling said user to customize said selected gift certificate (Granger, page 6, [0073]).

As per claim 7, Granger teaches all the claimed subject matters as discussed in claim 1, and further teaches enabling said user to select a mode of transmission used to transmit said selected gift certificate to said gift certificate recipient (Granger, page 1, [0015]).

As per claim 8, Granger teaches all the claimed subject matters as discussed in claim 1, and further teaches downloading said data indicative of an address of said gift certificate recipient via a communication medium from an address book stored on a terminal device of said user (Granger, page 5, [0059]).

As per claim 9, Granger teaches all the claimed subject matters as discussed in claim 1, and further teaches downloading said data indicative of an address of said gift certificate recipient via a communication medium from a web site address book (Granger, page 5, [0059]).

As per claim 10, Granger teaches all the claimed subject matters as discussed in claim 1, and further teaches downloading said data indicative of an address of said gift certificate recipient via a communication medium from a data storage device located remote from said automated gift certificate generation system (Granger, page 4, [0053]).

As per claim 11, Granger teaches all the claimed subject matters as discussed in claim 1, and further teaches generating a map that defines a travel path from said address of said gift certificate recipient to said merchant (Granger, page 3, [0044]).

As per claim 12, Granger teaches all the claimed subject matters as discussed in claim 11, and further teaches displaying a driving maps (Granger, page 3, [0044]), which inherently includes a list of a plurality of concatenated path segments, each of said plurality of concatenated

path segments comprising a definition of a predetermined identified travel path (please check [www.mapquest.com](http://www.mapquest.com), also see US Patent to Angwin, 6,559,865, col. 1, lines 30-35).

As per claim 13, Granger teaches all the claimed subject matters as discussed in claim 12, and further teaches displaying a driving maps (Granger, page 3, [0044]), which inherently includes data indicative of a distance traveled along each of said plurality of concatenated path segments (please check [www.mapquest.com](http://www.mapquest.com), also see US Patent to Angwin, 6,559,865, col. 1, lines 30-35).

As per claim 14, Granger teaches all the claimed subject matters as discussed in claim 13, and further teaches displaying a driving maps (Granger, page 3, [0044]), which inherently includes data indicative of an estimate of a time required to travel along each of said plurality of concatenated path segments (please check [www.mapquest.com](http://www.mapquest.com), also see US Patent to Angwin, 6,559,865, col. 1, lines 30-35).

As per claim 15, Granger teaches all the claimed subject matters as discussed in claim 13, and further teaches displaying a driving maps (Granger, page 3, [0044]), which inherently includes a written description of said travel path describing each of said plurality of concatenated path segments and said distance traveled along each of said plurality of concatenated path segments (please check [www.mapquest.com](http://www.mapquest.com), also see US Patent to Angwin, 6,559,865, col. 1, lines 30-35).

As per claim 18, Granger teaches all the claimed subject matters as discussed in claim 13, and further teaches displaying a driving maps (Granger, page 3, [0044]), which inherently includes generating a display to illustrate said travel path comprising each of said plurality of concatenated path segments and said distance traveled along each of said plurality of concatenated path segments (please check [www.mapquest.com](http://www.mapquest.com), also see US Patent to Angwin, 6,559,865, col. 1, lines 30-35).

As per claim 19, Granger teaches all the claimed subject matters as discussed in claim 18, and further teaches including said display with said gift certificate (Granger, Fig. 7).

As per claim 20, Granger teaches all the claimed subject matters as discussed in claim 1, and further teaches means for storing merchant information in a database (Granger, Fig. 4, elements 24, 25); and means for correlating said received gift certificate data with merchant information stored in said database to generate a list of said identified merchants (Granger, page 5, [0063]).

As per claim 21, Granger teaches all the claimed subject matters as discussed in claim 1, and further teaches means for activating an automated shopping expert program to guide said user through a series of queries to generate data to supplement said received gift certificate data (Granger, page 6, [0073]).

Claims 23-37 are rejected on grounds corresponding to the reasons given above for claims 1-15.

Claims 40-43 rejected on grounds corresponding to the reasons given above for claims 18-21.

The rejection to these claims are respectfully traversed. A system that provides store promotions, such as coupons and advertising to a vehicle as it is driven in certain proximity to a store, does not anticipate a system that accepts input regarding a gift recipient from a user for automatically generating and sending a gift certificate to a gift certificate recipient. Regarding Examiner's rejection of claim 1, Granger does teach an in-vehicle promotions system, whereby a system is installed in a vehicle that is able to retrieve promotions, such as coupons and advertising but not gift certificates, from stores as the vehicle is driven within a certain proximity of the store, however, Granger does not teach an automated gift certificate generation system for automatically identifying merchants to generate a gift certificate based on a location. Specifically, the Granger disclosure, "...a person can receive promotions information,..." does not anticipate "[a] means for receiving gift certificate data that designates a plurality of gift certificate data including at least one of: geographic location, merchant identification, recipient profile, recipient address, monetary value of said gift certificate, product characteristics, mode of delivery, delivery date. Granger teaches that store information, such as "...notification of a business' services and or products, sale, advertising discount or coupon information..." (Granger, page 1, [0008]) is received automatically in the user's vehicle automatically upon driving into a certain proximity of a store. Granger teaches a system that takes vehicle location data and compares this data with store proximity data to determine when to send promotional material to the vehicle occupant. (Granger, page 4, [0053]). This does not teach a system that receives gift certificate data that designates a plurality of gift certificate data. Furthermore, Granger does not teach gift certificate data particular to a gift recipient as entered by a user of the system.

In addition, Granger does teach automatically identifying a merchant located in an area located proximate to the vehicle as the vehicle comes in proximity to the merchant, however, this disclosure does not teach automatically identifying a

merchant located proximate the gift recipient's address or a geographical location of interest of the gift recipient. Granger teaches "...linking a position of the vehicle and a storage location of corresponding promotions information,...for automatically retrieving ...updated information linking the position and location of corresponding promotions information" (Granger, page 2, [0019]), which does not teach automatically identifying a merchant located proximate the gift recipient's address or a geographical location of interest of the gift recipient.

Also, Granger does teach that a vehicle occupant is able to select the particular stores of interest and the in-vehicle system displays promotional information related to that store, however, but this disclosure does not teach a system for enabling a user to select an identified merchant for the benefit of a gift recipient. Finally, Granger does not teach a system that provides a gift certificate including a monetary amount for a selected merchant. Claims 2 – 15, and 18 – 21 are patentable for this reason, and also because they all depend on a patentable claim.

Regarding claims 12 – 15 and 18, the Examiner has additionally cited the website [www.mapquest.com](http://www.mapquest.com) and U.S. Pat. No. 6,559,685 issued to Angwin as providing support for rejection under 35 U.S.C. § 102(e). These two references teach providing driving directions to a vehicle occupant, and as discussed above, do not in combination with Granger, provide support for a prima facie case of anticipation, which is generally based on a single reference, thus claims 12-15, and 18 are patentable in light of these two references.

The Examiner has rejected claim 19 as being anticipated by Granger, including Fig. 7 of Granger, however, claim 19 is patentable for above mentioned reasons, and also because it depends on patentable claim 18.

The Examiner has rejected claims 23 – 37 on the grounds corresponding to the reasons given above for claims 1 – 15. For the same reasons as stated above for claims 1 – 15, claim 23 is patentable and claims 24 – 37 are also patentable because they depend on a patentable claim 23.

The Examiner has rejected claims 40 – 43 on the grounds corresponding to the reasons given above for claims 18 – 21. For the same reasons as stated above for

claims 18 – 21, claims 40 – 43 are patentable because they depend on a patentable claim 23.

***Claim Rejections – 35 U.S.C. §103(a)***

The Examiner rejected claims 16, 17, 22, 38, 39, and 44 under 35 U.S.C. §103(a) as being unpatentable over Granger *et al.*, noting with respect to the claims:

As per claim 16, Granger teaches all the claimed subject matters as discussed in claim 15, and further teaches displaying gift certificate information, driving maps (Granger, page 3, [0044]) and a printer connected to the display (Granger, Fig. 10). Granger does not explicitly disclose printing driving description on said gift certificate. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to print the written driving description on said gift certificate. This provides the driving description to the user, and saves the user from the burden of searching map.

As per claim 17, Granger teaches all the claimed subject matters as discussed in claim 15, and further teaches displaying gift certificate information, driving maps (Granger, page 3, [0044]) and a printer connected to the display (Granger, Fig. 10). Granger does not explicitly disclose print written driving description on a printed media for a one of: insertion into said gift certificate, and attached to said gift certificate. However, it would have been obvious on of ordinary skill in the art at the time the invention was made to print the written driving description on the gift certificate by inserting or attaching to the gift certificate. This provides the driving description to the user, and saves the user from the burden of searching map.

As per claim 22, Granger teaches all the claimed subject matters as discussed in claim 1, and further teaches displaying/printing gift certificate (Granger, page 2, [0024]). Granger does not explicitly disclose incorporating merchant store operating data comprising at least one of: business hours, telephone number, WEB site address, into said certificate. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate at least one of business hours, telephone number, web address into the certificate. The business hours let a person know when the store is open. Telephone number and web address provides contact information to a person.

Claims 38-39 are rejected on grounds corresponding to the reasons given above for claims 16-17.

Claim 44 is rejected on grounds corresponding to the reasons given above for claim 22.

Applicant has reviewed the Granger reference and the Examiner's remarks and

has presented the following remarks in support of patentability.

As noted above, Granger does not teach all the claimed subject matter as discussed in claims 1 and 15, thus Granger does not teach all the claimed subject matter as discussed in claims 16, 17, and 22 which depends from patentable claims 1 and 15, respectively. Furthermore, Granger discloses an in-vehicle system for distributing promotional material to the occupant of the vehicle when the vehicle is within a certain proximity of a store, where:

Display 14 may be of the kind currently installed in vehicles and used to display vehicle operation information, driving maps, etc. System 10 may also include an indicator to alert a driver or passenger of the vehicle of the receipt of promotions information, more promotions information is waiting for display, the system is activated or remote communication is taking place. (Granger, page 3, [0044]).

However, the Granger reference is silent about providing gift certificate information or driving information printed on the gift certificate. This is because Granger teaches a system where the user is in a vehicle that is near or within eyesight of the store providing the promotional information, thus the occupant would easily be able to determine driving actions necessary or required to drive to the store. The in-vehicle display system 10 of Granger is simply an automated advertising system that provides coupons and promotional information to the user (occupant) of a vehicle as the vehicle enters a certain proximity of a store offering the promotional material. The user of the Granger reference is the vehicle occupant coming into proximity of various stores while driving. Conversely, the user of the present application is enabled to input data indicative of the gift certificate recipient to the automated gift certificate generation system, which then uses the gift certificate recipient data to identify merchants that are located in the vicinity of the gift certificate recipient, produces a list of available merchants that satisfy the selection parameters of the user, and upon selection by the user, generates and sends automatically a custom gift certificate, including driving directions, to the gift certificate recipient.

Regarding Examiner's rejection of claim 17, Granger is further silent regarding printing driving description on a printed media for a one of: insertion into said gift certificate, and attached to said gift certificate. Again, there is no gift certificate

involved with the Granger reference. Regarding Examiner's rejection of claim 22, Granger is again silent regarding incorporating merchant store operating data comprising at least one of: business hours, telephone number, WEB site address, into a certificate. The Granger reference does not teach Applicant's present system. Granger at most teaches being within a certain proximity of a merchant in a vehicle and receiving that particular merchant's promotional information. Granger is completely silent regarding the automatic generation and delivery of gift certificates to a gift certificate recipient, at their home or other geographical location, based on user input.

This is recited in claim 1 as follows:

1. An automated gift certificate generation system for automatically identifying merchants to generate a gift certificate based on a location, comprising:

means for receiving gift certificate data that designates a plurality of gift certificate data including at least one of: geographic location, merchant identification, recipient profile, recipient address, monetary value of said gift certificate, product characteristics, mode of delivery, delivery date;

means for automatically identifying at least one merchant located in an area located proximate at least one of: said address of said gift certificate recipient and said geographic location;

means for enabling said user to select at least one of said identified merchants; and

means for generating a gift certificate that defines a monetary amount of said gift certificate and said selected merchant.

The recited differences render independent claims 1 and 23 allowable under 35 U.S.C. §103(a) over the Granger reference. Applicant believes that claims 16, 17, 22, 38, 39, and 44 are also allowable under 35 U.S.C. §103(a) over the Granger reference since these claims are dependent on allowable base claims.

For the reasons explained above, it is believed that all of pending claims 1 – 44 are allowable and their consideration and allowance are respectfully requested. Applicant respectfully requests that a timely Notice of Allowance be issued in this case. The undersigned attorney requests Examiner Chen to telephone the undersigned if a conversation could expedite prosecution.

A Petition For Extension Of Time for three months, and the accompanying fee



are attached. Applicant authorizes the Commissioner to charge any additionally required payment of fees to Deposit Account #50-1848.

Respectfully submitted,  
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Dated 18 JUN 2004

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